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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,960

01/21/2004

Kazuya Hijii

17377

3891

23389

7590

09/25/2009

SCULLY SCOTT MURPHY & PRESSER, PC

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SUITE 300

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,960

Applicant(s)

HIJII ET AL.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-10, 12, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 17, 2009 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Goble (6,843,789).

Goble provides an electrosurgical system for the treatment of tissue, specifically the treatment and sealing of blood vessels (see, for example, col. 10, lines 10-15). The method of using the device includes the steps of generating and delivering a high frequency power to tissue, and measuring variables of the electrical signal (e.g. impedance) to determine the type and/or size of the tissue being treated. This determining step is then fed to a controller which sets the output values, including the number of pulses (or intermittent delivery) that is to be delivered to tissue. Column 20, line 39 through column 22, line 11 discuss the use of the device to deliver an initial pulse, monitor or detect impedance, and then controlling the output including the number of pulses to be delivered to tissue and the specific duty cycle and energy

delivered with each pulse or set of pulses. Column 24, lines 41+ discuss another embodiment that monitors electrical parameters of an initial pulse, then determines the output for subsequent pulses for treating tissue.

Response to Arguments

Applicant's arguments filed August 17, 2009 have been fully considered but they are not persuasive.

Applicant continues to assert that Goble et al fail to disclose the limitation of detecting tissue based on a maximal current value flowing to the subject tissue and the time up to the maximal current value. The examiner disagrees. Column 24, lines 41-56 specifically state that it is advantageous to monitor the time it takes to achieve a threshold (i.e. maximal) value. This is deemed to read on the limitation of "categorizing the subject tissue by detecting the maximal current value flowing to the subject tissue and comparing the time up to the maximal current value with a first threshold value". Specifically, lines 45-50 discuss the monitoring of parameters (e.g. output voltage) and the time it takes to reach a maximal value. The examiner maintains that output current and output voltage are inherently linked values, and that the measurement of the voltage is tantamount to measuring the current. Furthermore, Goble et al clearly disclose throughout the disclosure that alternative parameters (e.g. current, power, impedance) may be used in the monitoring phase. As such, the examiner maintains that Goble et al clearly disclose the monitoring of the time it takes to reach a maximal current value in the interest of determining future output pulses of the generator.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner, Art Unit 3739

/mp/
September 22, 2009